

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-21 are pending in the application, with claims 1, 16 and 18 being the independent claims. No claims are cancelled, and no new claims are added. Claims 12 and 13 have been amended herein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 12 and 13 under 35 U.S.C. § 112, second paragraph as being indefinite because. Applicant has amended claims 12 and 13 to address the Examiner's rejection.

Applicant respectfully requests the withdrawal of this 35 U.S.C. § 112, second paragraph rejection.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-2 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,733,483 to Lin. Independent claim 1 calls for "a sole for a shoe comprising: a midsole having at least one protrusion disposed in a forefoot region thereof; and a plate having at least one receptacle disposed therein, said plate

placed adjacent to said midsole such that said receptacle aligns with said protrusion,
wherein a diameter of said receptacle is not greater than a diameter of said protrusion."

The Examiner argues that Lin discloses "at least one protrusion 34 disposed in a forefoot region" and "a plate 18 having at least one receptacle 28 disposed therein." (Office Action at 2.) However, as illustrated in the figures, central receptacle 28 is large enough to receive *all* of the supporting elements 34 of insert 10. Lin discloses a midsole member 22 attached to a peripheral area of an upper surface 18 of outsole 14. Central receptacle 28 is the recess defined by the peripheral midsole member 22 that is dimensioned to receive the insert 10. See col. 2, lines 56-66. Thus, unlike the claimed invention, a diameter of the receptacle 28 - if there is a measurable diameter - is *much greater* than the diameter of any of the supporting elements 34.

Further, Lin discloses that "[u]pper surface 18 [of outsole 14] may be smooth and featureless throughout, or may have a central area 20 that is reticulated or webbed in order to save weight." Col. 2, lines 51-53. Accordingly, Lin does not teach or suggest a plate having at least one receptacle as claimed in independent claim 1. For at least these reasons, independent claim 1 is patentable over Lin. Claims 2 and 7 depend from an add further features to claim 1, and thus are patentable over Lin for at least the same reason as claim 1.

The Examiner has rejected claims 1-2, 14-15 and 18-19 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,076, 282 to Brue'. Independent claim 1 calls for " a sole of a shoe comprising: *a midsole having at least one protrusion disposed in a forefoot region thereof; and a plate having at least one receptacle disposed therein, said plate placed adjacent to said midsole such that said receptacle aligns with said*

protrusion, wherein a diameter of said receptacle is not greater than a diameter of said protrusion."

The Examiner argues that Brue' teaches "a midsole S having at least one protrusion 1, 1a disposed in a forefoot region; [and] a plate P having at least one receptacle 2 disposed therein." (Office Action at 3.) Unlike the claimed invention, the diameter of holes 2 is greater than the diameter of protuberance 1a. Col. 4, lines 32-35. Further, the specification of Brue' specifically recites that "in FIGS. 4, 5, 6 and 7, the *outsole* is indicated by the letter S, while the *insole* is indicated by the letter P." Col. 4, lines 55-57 (emphasis added). As such, Brue' does not teach or suggest "a midsole having at least one protrusion disposed in a forefoot region thereof" or "a plate having at least one receptacle disposed therein, said plate placed adjacent to said midsole," as claimed in independent claim 1. Instead, the protrusions identified by the Examiner are formed *in the outsole* and the receptacles identified by the Examiner, i.e., holes 2, are formed *in the insole* and not in a plate adjacent to a midsole. As such, Brue' does not anticipate independent claim 1. Claims 2, 14 and 15 depend from and add further features to claim 1 and are thus patentable over Brue' for at least the same reason as claim 1.

Independent claim 18 calls for, *inter alia*, "deflecting at least a portion of said protrusion into said receptacle." For example, according to the present invention, protrusions 522 bow into receptacles 318, thereby allowing for a small degree of vertical motion only in the vicinity of protrusions 522 with every step." Paragraph [0028] of the specification as filed and as published in U.S. Published Application No. 2005/0091881. Brue' does not teach or suggest the step of "deflecting at least a portion of said protrusion into said receptacle."

Instead, Brue' teaches "a small cylindrical protuberance 1a with a rounded tip, having a maximum diameter slightly less than the diameter of the holes 2," such that "protuberance 1a gradually 'occupies' the empty space of the holes 2, causing perfect centering of the holes 2 on the reliefs 1 during any walking conditions." As such, protuberance 1a does not "deflect" into hole 2, but instead entirely enters, or injects, into hole 2 without deflecting. With respect to the base of relief 1, on which protuberance 1a is attached, the specification of Brue' further comments, with respect to the first embodiment, that

The dimensions of the reliefs 1 and the holes 2 are designed so that the diameter of the base of the reliefs 1 is greater than the diameter of the holes 2 and this base therefore acts as support and occluding means of the holes themselves when the midsole is deformed downwards on account of the load applied by the foot or the accentuated bending of the shoe.

Col. 4, lines 20-26. With respect to the second embodiment, utilized in the Examiner's rejection, the specification states that

The internal surface of the outsole S also has, projecting from it upwards, cylindrical reliefs 1 with a cylinder-conical central protuberance having a rounded tip, entirely similar to those already illustrated in connection with the first embodiment of the present invention and therefore intended to cooperate with the holes 2 of the insole P. As a result of the precise fit between the outsole S and the insole P, resulting from joining together of the edge 10 and the seat 9, extremely precise engagement between each hole 2 and the respective relief 1 may be obtained, thus ensuring excellent performance of the forced-ventilation shoe according to the present invention.

Col. 5, lines 26-38. Since the midsole R or insole P is "deformed downward by the user's weight," and not the relief 1, this description teaches away from the present invention. As such, Brue' does not anticipate independent claim 18. Claim 19 depends from and adds further features to claim 18 and is thus patentable over Brue' for at least the same reasons as claim 18.

Applicant respectfully requests the withdrawal of the 35 U.S.C. § 102(b) rejections.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 8-10 and 20 under 35 U.S.C. § 103(a) as obvious over Brue' in view of U.S. Patent No. 6,199,304 to Ludemann and rejected claim 11 under 35 U.S.C. § 103(a) as obvious over Lin.

Claims 8-10 and 11 depend from and add further features to claim 1 and are patentable for at least the same reasons as claim 1, as discussed above. Claim 20 depends from and adds further features to claim 18 and is patentable for at least the same reasons as claim 18 as discussed above. Applicant, therefore, respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejections.

Allowable Subject Matter

Applicant appreciates the Examiners' allowance of claims 16-17 and acknowledgment that claims 3-6 and 21 include allowable subject matter. Claims 3-6 depend from and add further features to claim 1 and thus are patentable for at least the same reasons as claim 1. Claim 21 depends from and adds further features to claim 18 and thus is patentable for at least the same reasons as claim 18. Accordingly, Applicants respectfully request the withdrawal of the objections to claims 3-6 and 21.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the

Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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